

REMARKS

This amendment is offered in response to the Office Action of May 21, 2003.

The Applicants have amended Claim 14 to overcome the objection of numbered paragraph 1 of the Office Action.

The Office Action rejects the claims under 35 U.S.C. §101 as directed to non-patentable subject matter as allegedly no concrete or tangible result is produced. Similarly, the Office Action rejects the claims under 35 U.S.C. §112, first paragraph, for lack of enablement.

Attached hereto is a partial list of companies that have utilized the LEGO Serious Play concept which is the commercial embodiment of the presently claimed invention. Additionally enclosed are testimonials from the participants. The testimonials clearly establish the concrete and tangible results which were obtained.

Additionally, as stated in State Street Bank & Trust v. Signature Financial Group, 47 USPQ2d 1596, 1600 (Fed.Cir. 1998), “The plain and unambiguous meaning of §101 is that any invention falling within one of the four stated categories of statutory subject matter [process, machine, manufacture, or composition of matter] may be patented ...”. It is respectfully submitted that the present invention is a new and useful process and is patentable under Title 35 of the U.S. Code, including section 101.

The Office Action rejects Claims 1-14 under 35 U.S.C. §112, second paragraph. It is respectfully submitted that the phrase “to serve as physical metaphors” is made definite by the amendment of Claim 1 to recite “models with connectable and detachable building blocks to serve as physical metaphors” (underlined language added). That is, the models that serve as metaphors are physical models built from connectable and detachable building blocks. Furthermore, the specification at page 7, lines 12-19 gives fully definite examples of what such

metaphors could be. Similarly, the phrases “relating to aspects of the topic” and “how the features of the model relate to the topic” are discussed in the first paragraph of the “Detailed Description of Preferred Embodiments” (the paragraph bridging pages 4 and 5). It is respectfully submitted that the relationship of the “metaphors” to the “aspects of the topic” are discussed throughout the specification in such definite terms as to make these phrases definite within the context of the claims. Similarly, the Applicants traverse the rejection regarding the language “involves” and “business planning” (Claim 2). It is respectfully submitted that the specification is replete with examples of topics involving business planning, and that there would be nothing indefinite in these terms to one skilled in the art of corporate human resources, corporate management and similar fields. Similarly, the terms “represents” and “an aspect” appear in claim 3 in the phrase “wherein at least one of the metaphors represents an aspect of a company”. Again, the examples given at page 7, lines 12-19; page 9, line 5 through page 10, line 2; the paragraph bridging pages 11 and 12; and throughout the specification make this claim language definite.

The phrase “how that relates to how the company and its customer interact” as well as the phrase “how to address changes in how the company and its customer interact” is discussed and made definite by the language in the paragraph bridging pages 15 and 16 and throughout the specification.

Similarly, the phrase “represent” in Claim 9 relates to “real people” which is fully discussed and made definite by the first full paragraph of page 10 and the phrase “representing guiding principles” is discussed in the specification and made definite by the paragraph bridging pages 4 and 5 (see page 5, line 4); the last full paragraph of page 13 (see page 13, line 16); the last full paragraph of page 16 (see page 16, line 18); and throughout page 18 (see page 18, lines

5, 7, 9 and 17). Moreover, such a term would be well understood by one skilled in the art of corporate human resources and similar fields.

It is therefore respectfully submitted that the claims are definite under 35 U.S.C. §112, second paragraph. However, the Examiner is respectfully invited to telephone Applicants' attorney if any changes in language, without altering the underlying meaning of the claims, might be suggested.

The Office Action rejected Claims 1-14 under 35 U.S.C. §103(a) as being obvious over the Corporage reference. It appears that the Corporage reference merely discloses that jigsaw puzzle events (occurring in a list which further includes such items as road rallies, murder mysteries and paint ball wars) can be used for corporate team building. This is quite different from the language of newly-amended Claim 1 which recites, *inter alia*:

causing the participants to construct models with
connectable and detachable building blocks to serve as physical
metaphors, said metaphors relating to aspects of the topic;
reconfiguring said models as a plurality of new objects;

There is nothing in this prior art reference to disclose or suggest that the jigsaw pieces be used as a metaphor relating to aspects of the topic. Rather, it would seem that the prior art discloses a team effort to solve a jigsaw puzzle (which is not "connectable and detachable building blocks") as a "bonding" event. That is, the puzzle or pieces thereof are not going to serve as metaphors. Moreover, the jigsaw puzzle is not going to result in models (i.e. plural) which are reconfigured as "a plurality of new objects".

Moreover, a jigsaw puzzle can typically be put together with only one final result, thereby removing any creativity in the result. This is quite different from the present invention

which allows the blocks to be put together in a large but finite number of ways, thereby providing for a creative result, within the constraints imposed by the building blocks. This later feature clearly distinguishes the claimed effort from painting or sculpting where no bounds are imposed on the final product. The use of connectable and detachable building blocks (i.e., such as those sold under the LEGO trademark) permit ready participation without the constraints imposed by a jigsaw puzzle or requiring the specific talents of painting or sculpting.

It is therefore respectfully submitted that Claims 1-14 are patentable over the Corporage reference.

For all of the reasons above, it is respectfully submitted that all of the presently pending claims are in immediate condition for allowance. The Examiner is respectfully requested to withdraw the rejections of the claims, to allow the claims, and to pass this application to early issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Gerald Levy', is written over the printed name and registration number.

Gerald Levy
Registration No. 24,419

Pitney, Hardin, Kipp & Szuch, LLP
685 Third Avenue
New York, New York 10017
212-297-5800